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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,095	10/25/2000	Mitsuharu Kamiya	00754/LH	3189

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/696,095

Applicant(s)

KAMIYA, MITSU HARU

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 57-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

At lines 5-8 of each claim 57 and 60, the following is new matter: "user information storage means/device for storing/which stores user information regarding information terminals which are permitted to access the printing information distributing apparatus".

At claim 57 lines 11-19, and similarly at claim 60 lines 11-18, the following is new matter: "information terminal authenticating means/device for acquiring/which acquires, when one of the information terminals accesses the printing information distributing apparatus through the network, identification information indicating a user of the one of the information terminals accessing the printing information distribution apparatus, and for performing/performs authentication to determine whether or not the user of said one of the information terminals is stored in the user information storage means/device".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 57-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At claim 57 lines 17-19, and similarly at claim 60 lines 16-18, determining “whether or not the user of said one of the information terminals is stored in the information storage means” (emphasis added) is indefinite: Surely it is information, not the user, which applicant intends to store in the information storage means. This rejection can be overcome by amending claims 57 and 60 to read, “... whether or not the user information of said one of the information terminals is stored in the information storage ...”.

At claim 57 lines 11-19, and similarly at claim 60 lines 11-18, “information terminal authenticating means” is indefinite because it does not contain limitations as to authenticating the information terminal. It is limited to acquiring “identification information indicating a user” and determining whether or not the user information is stored. Such limitations read on authenticating a user, not authenticating a terminal.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 57-62 are rejected under 35 U.S.C. 102(e) as being anticipated by Withrow (US006116505A).
8. Withrow teaches (independent claims 57 and 60) a *final receipt* (col. 15 line 44) printing information distribution apparatus (*central control system 50*, col. 4 lines 41-61 and col. 9 lines 18-33) which is adapted to be connected to *fuel dispensers 18* information terminals and printers (printers of the *remote POS or transaction terminals 30, 34 and 36* at the store or restaurant, col. 4 lines 1-12 and col. 13 lines 43-44) located at different places, through a

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network (Fig. 4-8) comprising: means for credit/debit transaction authorization (col. 9 lines 26-30), which reads on user information storage means, information terminal authenticating means, printer authenticating means and identification information fetching means (para. 9 below); and a database/transaction account means (col. 9 line 63 to col. 10 line 4), which reads on printing reservation information and storage means.

9. A credit/debit card transaction authorization system (*host transaction network 94*, col. 9 lines 28-29) must have the address of the terminal at which the credit/debit card user is attempting to execute a transaction. Said address reads on user information regarding information terminals that are permitted to access the printing information distribution apparatus (*central control system 50*, col. 4 lines 41-61 and col. 9 lines 18-33). The credit/debit card transaction authorization system (*host transaction network 94*, col. 9 lines 28-29) acts as printer authenticating means and identification information fetching means when a user uses their credit/debit card at one of the *remote POS or transaction terminals 30, 34 and 36* at the store or restaurant.
10. Withrow does not explicitly teach printing information generating (retrieval) and transmission means/device. However, since the structure recited in the reference is substantially identical to that of the claims, these claimed properties or functions are presumed to be inherent (MPEP § 2112.01). As evidence tending to show inherency, it is noted that the reference does teach means/devices to put the transaction information to be printed into a transaction account (col. 10 line 4) and printing said transaction information (col. 15 line 44) at a printer of the *remote POS or transaction terminals*. Hence there must be means/devices for performing the intermediate steps of retrieving the information and transmitting it to the printer.
11. Withrow also teaches (claims 58, 59, 61 and 62) payment with a credit card (col. 14 lines 7-8), which reads on charge transmitting means and money entry means. Paying for goods inherently reads on paying for printing of the receipt for said goods.
12. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness,

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and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

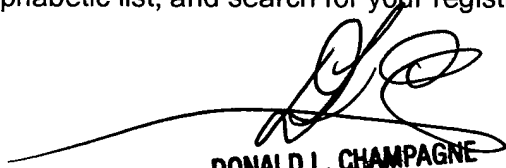
13. The instant application contains no such clear definition for a number of key claim terms. For example, the examiner could not find a "clear definition" for the term "reservation". In the instant case, the examiner is required to give such terms their broadest reasonable interpretation. For "reservation", the examiner interpreted the term to mean retaining or reserving transaction information in an account (col. 10 line 4) as a prelude to printing a receipt with said information.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
15. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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17. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

6 March 2006